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IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-1185

MURRAY FIELDS, and
CONSOLIDATED FOODS CORPORATION,

Petitioners,

v.

WILLIAM E. SCHUYLER, JR.,
Commissioner of Patents,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioners, Murray Fields and Consolidated Foods Corporation, a corporation of Delaware, pray that a Writ of Certiorari be issued to review the Judgment of the Court of Appeals for the District of Columbia Circuit entered on October 16, 1972.

I. Orders, Opinions and Judgments below.

A. Opinion (No. 71-1525) F.2d , 175 USPQ 514, and the Judgment of the Court of Appeals for the District of Columbia Circuit, both dated October 16, 1972 (1a-5a; 19a).*

B. Memorandum of the United States District Court for the District of Columbia dated March 11, 1971 (6a-8a).

C. Decision of Patent Office Board of Appeals dated July 1, 1968, Appeal No. 82449 (9a, 10a).

D. Patent Office Examiner's final rejection dated July 24, 1967 (11a, 12a).

II. Statement of the Ground on Which Jurisdiction of This Court is Invoked.

(a) This is a suit arising under the patent laws of the United States, Title 28, Sec. 1338, of the United States Code.

(b) The jurisdiction of this Court is invoked under Title 28, Sec. 1254 of the United States Code.

(c) The judgment which the Petitioners ask to be reviewed herein was entered October 16, 1972 (19a). No petition for rehearing was filed. An application to extend the time to file this Writ of Certiorari was requested and on January 11, 1973 Mr. Chief Justice Burger signed an order extending the time to and including the 28th day of February 1973.

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* References in parentheses refer to pages of the appendix accompanying this petition.

III. Questions Presented for Review.

1. Do this Court's decisions in *Gorham Mfg. Co.* v. *White,* 14 Wall. 511 (1872); *Smith* v. *Whitman Saddle Co.,* 148 U.S. 674 (1893); and *Graham* v. *John Deere Co.,* 383 U.S. 1 (1966) require, as to design patent subject matter, that the person having ordinary skill in the art mentioned in §103 of the Patent Act of 1952 be defined as "the ordinary intelligent man"?

2. Do the decisions mentioned in question 1 hereinabove require that evidence of commerical success be accorded significant weight in formulating the test of "the ordinary intelligent man"?

IV. Statute Involved.

The Patent Act of 1952, §103 (35 U.S.C. 103).

> *"Conditions for patentability; non-obvious subject matter*
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1952, c. 950, § 1, 66 Stat. 798."

V. Statement of the Case.

A. The proceedings below and basis for Federal Jurisdiction.

This is an action against the Commissioner of Patents pursuant to the provisions of the United States Code Title 35, Section 145 for a decree that Petitioner is entitled to receive Design Letters Patent for the design of a writing implement shown and described in a patent application therefor, Serial No. D-1184 filed February 25, 1966. A copy of the patent drawing of the design at issue is included in the Appendix (14a).

The original application was made by the Petitioner, Murray Fields, and the application was assigned to the Petitioner, Consolidated Foods Corporation. The term "Petitioner" is used herein to refer to both Petitioners unless otherwise noted.

Petitioner's claim for design patent was finally rejected on July 24, 1967 (12a). The Examiner was affirmed by the Board of Appeals of the Patent Office (10a). This action to authorize the Commissioner of Patents to issue a design patent to Petitioner was started in the District Court for the District of Columbia, and after a trial had on November 24, 1970, the District Court dismissed the Complaint. The Petitioner appealed to the Court of Appeals for the District of Columbia Circuit which affirmed the District Court (5a, 19a).

B. Facts material to the consideration of the questions presented.

Petitioner's design is novel. It is not identical to any of the references cited during the patent prosecution (7a,

10a). On July 24, 1967, the Patent Office Examiner made the final rejection of Petitioner's claim under the provisions of 35 USC 103 (obviousness) (12a) citing four references as follows:

Design Patents

Bunn	D. 188,267	June 1960	(11a, 15a)
Harper et al	D. 179,538	Jan. 1957	(11a, 16a)
Platt	D. 189,735	Feb. 1961	(11a, 17a)

Washington Star Pictorial Magazine, November 15, 1953, Page 11, top cut, Scripto ball point pens (11a, 18a).

The Examiner's rejection deemed the Petitioner's advancement in design to be obvious "to a person of ordinary skill working in this field and therefore unpatentable under the provisions of 35 USC 103" (11a). Each of the four references was selected by the Examiner for a particular feature of detail which he attempted to match to particular details of Petitioner's design (11a). A summary of these features was made by the Examiner in his final rejection as follows:

> "Platt teaches the combination of a pen having faceted upper sides and a squared push button at the top. In view of such teaching, the application of the Bunn type flat facets to the cap portion sides of the Star Pictorial item pen and the squaring of the push button thereof in the manner shown by Harper are deemed to be obvious modifications *to a person of ordinary skill working in this field* and therefore unpatentable under the provisions of 35 USC 103". (11a) (Italics supplied)

It is submitted that the Examiner in the Patent Office made an error in law in applying the rule of obviousness as he did. The Examiner's rule was beased on a comparison of Petitioner's design (which was admittedly not identical with any of the references) to a hindsight redesigning, or new designing, by a person of ordinary skill working in the art, to reconstruct Petitioner's design out of elements found in prior art objects, after viewing the teaching of Petitioner's design. The Examiner did not apply the test of whether the claimed design, as a whole, would appear to "the ordinary intelligent man" to be obvious from the prior art.

C. Evidence of commercial success.

At the trial in the District Court below, Petitioner introduced evidence of commercial success showing the sales of pens embodying the design (SQ pen style) and the relation of such sales to the total pen sales of the Petitioner, Consolidated Foods Corporation. This evidence showed total sales of the design between 1965 and 1970 to be well over three million dollars. It demonstrates a ratio of increase of sales of the pen of the claimed design over the other models of the company from a small percentage in 1965 to over 18% in 1970. (Petitioner's Exhibit 6; 13a). These are additional important and material factors bearing on the issues in this matter.

VI. Argument for the Allowance of the Writ.

A. The courts are in Conflict in Applying the Obviousness Test of "The Ordinary Intelligent Man" in Design Cases.

1. *Background.*

The patentability of the subject matter and the validity of a mechanical patent as well as a design patent depend on novelty, utility and non-obviousness. Although the Patent Laws were amended, revised or codified some 50 times between 1790 and 1950, Congress steered clear of a statutory set of requirements other than the bare novelty and utility tests of the 1793 Patent Act. This Court, not Congress, first formulated a general condition of patentability in 1851 in *Hotchkiss* v. *Greenwood,* 11 How. 248, 13 L. ed. 683, which together with cases that followed gave birth to "invention" as a word of legal art signifying the exercise of "inventive faculty" which produced patentable invention, as distinguished from the work of the ordinary mechanic which did not. A large variety of opinion as to meaning and interpretation developed in the courts, the Patent Office and at the bar, including the controversial requirement for a "flash of creative genius". *Graham* v. *John Deere Co.,* 383 U.S. 1, 10, 11, 12, 15 (1966).

The Patent Act of 1952 set out the conditions of patentability in three sections; novelty and utility in §101, §102, and non-obviousness (a new statutory formulation for the less definite term "invention") in §103. The new section abolishes the "flash of creative genius" test but otherwise is intended merely as a codification of judicial precedents with congressional direction that injuiry into obviousness is a prerequisite to patentability. The emphasis on non-obviousness is one of inquiry, not quality, and is still based on judicial precedents as formulated

prior to the Patent Act of 1952. *Graham* v. *John Deere Co., supra,* 12, 15, 17.

§103, negatives patentability, even though the subject matter is novel and useful if:

> "• • • the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made *to a person having ordinary skill in the art* to which the subject matter pertains." (Italics supplied)

The application of the section to design cases has been variously interpreted as matter of law by Courts of Appeals of different Circuits and by the Court of Customs and Patent Appeals.

The Court of Customs and Patent Appeals and the Ninth Circuit construe the "person having ordinary skill" in the design art as "the ordinary intelligent man". *In re Laverne and Laverne,* 356 F. 2d 1003, 1006 (C.C.P.A. 1966) and *Schwinn Bicycle Co.* v. *Goodyear Tire and Rubber Co.,* 444 F. 2d 295, 299 (9th Cir. 1970).

The Second, Third, and Fourth Circuits, as well as the District of Columbia Circuit, below, make a literal construction of the statute, having an artisan or designer rather than the ordinary intelligent person in mind. *Rains* v. *Niaqua, Inc.,* 406 F. 2d 275, 278 (2d Cir. 1969); *Hadco Products, Inc.* v. *Walter Kidde & Co.,* —— F. 2d ——, 174 U.S.P.Q. 358, 365 (3rd Cir. 1972); *Blumcraft of Pittsburgh* v. *Citizens & Southern Natl. Bank,* 407 F. 2d 557, 559 (4th Cir. 1969); *Fields* v. *Schuyler,* —— F. 2d ——, 175 U.S.P.Q. 514, 516 (D.C. Cir. 1972) in which the Court below expressly stated: "• • • the statute [§103] calls for application as written • • •" (5a).

It is the purpose of this petition to show that the error of the Court below is shared by at least three other Circuits to the end that the design patent law becomes unworkable in a major portion of the United States of America.

2. *The pertinent judicial precedents.*

How is the phrase "to a person having ordinary skill in the art" to be construed with respect to design subject matter? In order to answer, we must follow this Court's lead and look to the judicial precedents codified by §103.

The earliest pertinent design patent cases decided by this Court in *Gorham Mfg. Co.* v. *White,* 14 Wall. 511, 525 (1872). In that decision, the Court said with reference to designs:

> "• • • the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. It, therefore, proposes to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them. Manifestly, the mode in which those appearances are produced has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself which attracts attention and calls out for favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not en-

tirely, the contribution to the public which the law deems worthy of recompense."

Later, in *Smith* v. *Whitman Saddle Company,* 148 U.S. 674, 679, 680 (1892), this Court recognized that:

> "• • • the law applicable to design patents 'does not materially differ from that in cases of mechanical patents, and "all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries . . . shall apply to patents for designs. • • • To entitle a party to the benefit of the act, in either case, there must be originality, and the exercise of the inventive faculty.'"

The Court then applied the rule laid down in *Gorham Mfg. Co.* v. *White, supra,* as follows:

> "• • • the true test of identity of design is sameness of appearance,—in other words, sameness of effect upon the eye; that it is not necessary that the appearance should be the same to the eye of an expert, and that the test is the eye of an ordinary observer, the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give."

The Third Circuit followed *Gorham* v. *White,* supra, in *J. R. Wood & Sons, Inc.* v. *Abelson's, Inc.,* 74 F. 2d 895, 896 (3d Cir. 1934) in an opinion which referred to numerous judicial precedents, as follows:

> "• • • A design is patentable, if it presents to the eye of the ordinary observer a different effect from

> anything that preceded it, and renders the article to which it is applied pleasing, attractive, and popular."

In, *Application of Johnson*, 175 F. 2d 791, 792 (C.C.P.A. 1949) a pre-1952 decision, the Court of Customs and Patent Appeals restated the judicial test for design patent validity as follows:

> "Courts in considering design patents almost universally apply the rule that it is not enough if a particular design be new, original, and ornamental, but there must be present the exercise of the inventive faculty as well. The courts seem to be of one accord in stating that the fourth element of the formula which tests the patentability of a design, viz., the exercise of the inventive faculty, defies definition and resides as a subjective standard in the mind of the judge considered as an 'average observer.'" (Citing *Gorham Mfg. Co.* v. *White, supra; Smith* v. *Whitman Saddle Co., supra;* and others).

The foregoing authorities represent judicial precedent to the Patent Act of 1952 which in accordance with this Court's conclusion (that the Act was intended to codify judicial precedent) shows that the general level of innovation or "inventive faculty" necessary to sustain patentability in a design invention, was decided by the courts following *Gorham* v. *White, supra,* and *Smith* v. *Whitman Saddle Co., supra,* through the eyes of the "average observer" or "the ordinary intelligent man".

3. *Judicial trends after §103.*

a. The ordinary intelligent man.

Since the enactment of §103, two divergent trends as to statutory interpretation have appeared. The first trend continues traditional precedent by defining section 103's "person having ordinary skill" in the design art as "the ordinary intelligent man". This definition not only leaves the standard of design invention unchanged (agreeing with this Court's conclusion in *Graham*) but also provides the courts with an understandable frame of reference like "the reasonable man" within the frame of reference of negligence. This will result in the uniformity and definiteness which Congress called for in the 1952 Act. *Graham* v. *John Deere Co., supra,* 18.

The second trend (followed by the Court below) calls for the application of §103 strictly as written, leaving no room for continuing the traditional judicial precedents, and unmindful of this Court's conclusion "that the general level of innovation necessary to sustain patentability remains the same". The Court of Customs and Patent Appeals and the Ninth Circuit follow the first trend and continue to use "the ordinary intelligent man" test.

In Re Laverne and *Laverne, supra,* was decided on March 10, 1966, just a few weeks after the Supreme Court made its decision in *Graham* v. *John Deere Co., supra.* The Court of Customs and Patent Appeals found the "person having ordinary skill" in the design art to be the now familiar "ordinary intelligent man".

Finally, the complete circle of the first trend judicial precedent is set forth by the Ninth Circuit in a way which is compatible with precedent, statute, and continued workability of the design patent law. In *Schwinn Bicycle Co.* v.

Goodyear Tire and Rubber Co., supra, 298, 299, the Ninth Circuit had this to say about the application of the rules of *Graham, supra,* to design cases:

> "*Graham* involved a mechanical (or utility) patent and some of the language therein does not fit design patent cases with precision. Nonetheless, the statutory criteria of non-obviousness is specifically incorporated into design patent applications by the language of 35 U.S.C §171, and we are convinced that the approach of *Graham* is equally applicable where the question is the obviousness of a design patent.
>
> • • •
>
> In design patent cases, there has been some confusion as to the appropriate method of determining the level of ordinary skill in the art. See In Re Laverne 356 F. 2d 1003, 53 CCPA 1158 (1966). In *Laverne,* the Court of Customs and Patent Appeals (which has the responsibility of deciding numerous cases from the Patent Office regarding the patentability of designs), reflected the suggestion that the pertinent inquiry was to the 'expected skill of a competent designer' and re-affirmed its view that the determination must be 'obviousness to the ordinary intelligent man.'
>
> We think this is the appropriate measure and one which has substantial historical backing. Over 70 years ago, the Supreme Court stated the test thus:
>
> 'The test is the eye of an ordinary observer, the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give.' Smith v. Whitman Saddle Co., 148 U. S. 674, 680 (1893)."

b. The second trend—the ordinary designer.

The District of Columbia Circuit, it is submitted, erroneously followed the second trend and chose a test for obviousness by a person of ordinary skill working in the field, following *Blumcraft of Pittsburgh* v. *Citizens & Southern Natl. Bank, supra* 559, wherein it was stated:

> "Title 35 U.S.C §103 denies patentability to a novel design if the differences between the design and the prior art are such that the design would have been obvious to a person skilled in the art of designing ornamental railing."

For simplicity, we call this second judicial trend since the 1952 Act "the ordinary designer" test to distinguish it from "the ordinary intelligent man" test first defined by this Court in *Smith* v. *Whitman Saddle Company, supra.* The other Circuits using "the ordinary designer" test are: the Second, "the ordinary designer who is chargeable with knowledge of the prior art" (*Rains* v. *Niaqua, supra* 278), and the Third, "obviousness to a worker of ordinary skill in the art" (*HADCO Products, Inc.* v. *Walter Kidde & Co., supra,* 365).

It is submitted that no Circuit Court using "the ordinary designer" test has held a design patent valid since *Graham* v. *John Deere, supra.* This interpretation raises the standard of invention for design patents to the extent that the design patent laws are unworkable in a major portion of the United States. It is submitted that in *HADCO Products, Inc.* v. *Walter Kidde & Co., supra,* 365, the Third Circuit Court went even further in raising the standard by saying that under §103 considerably more is required to warrant a patent than such novelty as might result from the exercise of designing skill of a designer in varying artistic details and the size and shape of the article and its contours.

The same design patent can be held valid in a jurisdiction holding with "the ordinary intelligent man" and invalid in a jurisdiction holding with "the ordinary designer". The Court of Customs and Patent Appeals (which shares appellate jurisdiction over the Patent Office) may order a design patent to be issued as non-obvious and valid, only to have the same patent declared invalid on the same facts for obviousness in either the Second, Third, or Fourth Circuits, and even in the District of Columbia Circuit, below (which, incidentally, shares appellate jurisdiction over the Patent Office).

In support of this petition, it is submitted that the Courts of Appeals together with the Court of Customs and Patent Appeals are in conflict on an important question of Federal law in a way which conflicts with the applicable decisions of this Court.

B. Commercial Success is a Significant Factor in Applying the Test of "The Ordinary Intelligent Man".

To paraphrase the language of this Court: patent validity requires reference to the Constitutional standard which limits it to the promotion of progress in the "useful arts" with "regard to the innovation, advancement or social benefit gained thereby". *Graham* v. *John Deere Co., supra,* 5, 6. In a design patent particularly, the advancement is measured by the social benefit resulting from the new and original appearance which may enhance the "saleable value" of a manufactured article, enlarge the demand for it, be a "meritorious service to the public" and constitute "the contribution to the public which the law deems worthy of recompense". *Gorham Mfg. Co.* v. *White, supra,* 525.

Under the cited authority, commercial success reflects the specific reaction of the "ordinary intelligent man" to the design innovation with relation to the state of the art. It is a potent factor to measure the advancement by social benefit gained by the public. This is not a new concept.

The Seventh Circuit in *Standard Match Corporation* v. *Bell Machine Company,* 83 F. 2d, 365, 367 (7th Cir. 1936) had this to say nearly forty years ago:

> "Upon the question of validity, the discussion will be brief. * * * Whether a design which is novel and ornamental is entitled to coverage by a design patent depends to a large degree upon the reception which those for whom it is made, accord it. If pleasing to the eye and acceptable to the trade as evidenced by extensive sale, we would naturally be inclined to uphold it. In so doing we are not delegating judicial powers to others, but rather applying a test of patentability."

Commercial success confirms that design subject matter has distinctive and desirable features not found in the prior art. This is so because the objective is to enhance saleable value. *Robert W. Brown & Co.* v. *De Bell,* 243 F. 2d, 200, 202 (9th Cir. 1957).

Commercial success is recognized as having especial importance in determining the validity of design patents. *Glen Raven Knitting Mills* v. *Sanson Hosiery Mills,* 189 F. 2d 845, 853 (4th Cir. 1951).

The Court of Appeals below swept away all consideration of commercial success in this case, saying (5a):

> "Yet if the ultimate standard were to turn on originality from the point of view of the average observer, commercial success would become a vir-

tually conclusive determinant, and not merely a secondary indicator, of patentability."

It is respectfully submitted that evidence of commercial success is not to be swept away because it would be a virtually conclusive determinent from the point of view of the average observer. Commercial success is, and always has been in accordance with the judicial precedents cited herein, a primary indicator of what goes on in the mind of "the ordinary intelligent man" when he spends his money for the desired innovation. It is submitted that although according to *Graham, supra,* 17, 18, it may have relevancy as a "secondary consideration" to the study of the actual prior art, commercial success is nevertheless of importance as an indicia of obviousness or non-obviousness. *Gorham Mfg. Co.* v. *White, supra,* especially refers to the "saleable value" as a factor making up the advancement contributed by the inventor of design subject matter to the public.

C. Conclusion: The Writ Should Be Granted

The Second, Third, Fourth and the District of Columbia Circuits are in conflict with the Court of Customs and Patent Appeals and the Ninth Circuit in deciding an important Federal question under applicable decisions of this Court. The Writ should be granted.

Respectfully submitted,

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United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 71-1525

MURRAY FIELDS

CONSOLIDATED FOODS CORPORATION,
APPELLANT

v.

WILLIAM E. SCHUYLER, JR.

Appeal from the United States District Court
for the District of Columbia

Decided October 16, 1972

Mr. Edward Halle, of the bar of the Court of Appeals of New York, *pro hac vice,* by special leave of Court, with whom *Mr. Albert H. Kirchner* was on the brief, for appellants.

Mr. John W. Dewhirst, Attorney, U.S. Patent Office with whom *Mr. S. William Cochran,* Solicitor, U.S. Patent Office was on the brief, for appellee.

Before: WRIGHT, LEVENTHAL and MACKINNON, *Circuit Judges.*

LEVENTHAL, *Circuit Judge*: This is an appeal by plaintiff-appellant[1] from a judgment dismissing the complaint, brought under 35 U.S.C. § 145, to have the District Court authorize the issuance of a design patent for the ornamental design of a pen. The essential features of the design disclosed by the claim pertain to the upper portion, above the annular ring, on the barrel of a ballpoint pen, which is round in cross-section, and gradually flattens on the sides by means of facets, until it is squared at the top in cross-section. The top is provided with a square push button; and both the top of the barrel and the push button are angled downward.

The District Court dismissed the complaint stating:

> Title 35 USC 103 denies patentability to a novel design if the differences between the design and the prior art are such that the design would have been obvious to one skilled in the art.

It upheld the determination of the Patent Examiner, who concluded that the advancement in design was obvious to a person of ordinary skill working in this field, and of the Board of Patent Appeals, which stated that appellant's design was so similar to the prior art as to be a minor modification thereof rather than a new design.

In these cases there is a presumption of correctness of the Patent Office determination, and a separate presumption in favor of the findings of the District Court, in the absence of clear error. Appellant submits that this case, however, involves a distinct error of law. The error is identified as the application of the general rule denying patentability for advances "obvious . . . to a person having ordinary skill in the art," 35 U.S.C. § 103, without attention to the requirement that in the case of design patents,

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[1] There are two plaintiffs; we use the singular for convenience.

this requires a determination that the advance was obvious to the "ordinary intelligent man." Appellant relies particularly on In re Laverne and Laverne, 356 F.2d 1003 (C.C.P.A. 1966) and Schwinn Bicycle Co. v. Goodyear Tire and Rubber Co., —— F.2d ——, 168 U.S.P.Q. 258 (9th Cir. 1970).

The District Court relied on Blumcraft of Pittsburgh v. Citizens & Southern Natl. Bank, 407 F.2d 557, 559 (4th Cir. 1969), citing Graham v. John Deere Co., 383 U.S. 1, 17 (1966), which applied the statutory term (obviousness "to a person having ordinary skill in the art"), without any special gloss for design cases. *Blumcraft* did not discuss *Laverne* and the problems ventilated there. But *Laverne,* and *Schwinn,* were attentively analyzed in HADCO Products, Inc. v. Walter Kidde & Co., 174 U.S.P.Q. 358 (3d Cir. 1972).

We find Judge Forman's opinion in *HADCO* to provide a careful analysis of the problem and we join in the Third Circuit's ruling and its rejection of the approach of *Laverne* and *Schwinn.* Judge Forman's opinion acknowledges that the test of the "ordinary observer" has applicability in determining the novelty and ornamentality of a design, and that this standard, like the "ordinary intelligent man" standard of *Laverne,* must ultimately "rest on the subjective conclusion of each judge." However, the Third Circuit gives effect to the statutory standard, which denies patentability to an advance obvious at the time to a person of ordinary skill in the art, by concluding that the ultimate determination of obviousness or non-obviousness of claimed design turns on "an objective finding that similarity of appearance was so lacking in the prior art as to render the [claimed] design as a whole non-obvious to a worker of ordinary skill."

In short, while the judge must rely on his own visual impression as to whether the claim design is novel in the

sense of conveying an aesthetic effect substantially different from that previously seen in the art, there is also a more objective reference point when he comes to consider whether the new design "reflected originality born of inventive faculty,"[2] or was obvious to one skilled in the art.[3]

We acknowledge that some interesting questions are raised in the *Laverne* and *Schwinn* opinions as to the possible need for a different gloss on the obviousness standard in the case of design patents. But we are in no position to say that a judge's effort to determine what is "obvious . . . to a person skilled in the art" will stifle design creativity. The judge's experience enables him to compensate for the tendency of inventions to look obvious—with

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[2] R. M. Palmer Co. v. Luden's Inc., 236 F.2d 496, 501 (3rd Cir. 1956).

[3] Appellant argues that in *Deere* the Supreme Court held that the 1952 statutory formulation in 35 U.S.C. § 103 merely codified the prior law, and that the prior law prescribed an "average observer" reference point for design patents, citing In re Johnson, 175 F.2d 791 (C.C.P.A. 1949).

We have examined Gorham Mfg. Co. v. White, 14 Wall. 511 (1872), cited in *Johnson* as the source of the "average observer" reference point, and note that there the Court was stressing that an average observer might find two designs the same (for the purpose of infringement), though an expert might detect differences. *Johnson* also cites Smith v. Whitman Saddle Co., 148 U.S. 674 (1893), but there the Court held patentability negatived because the changes in design of a saddle were of a kind in common practice among ordinary workmen in the field. 148 U.S. at 681. The last paragraph of *Johnson* also refers to the inventive faculty as negatived by design adaptations for pipe pliers that reflected "obvious expedients to a designer skilled in the art."

We discern no significant doctrinal deviation in the prior law that requires an implies exception or modification to be read into the 1952 amendment for the case of design patents.

the 20-20 vision of hindsight. And he will know how to use the "average observer" as an indicator of patentability, especially in an area of consumer goods design, where the patent is not a reward for an advance in utility so much as for distinctiveness, ornament and aesthetic satisfaction. Yet if the ultimate standard were to turn on originality from the point of view of the average observer, commercial success would become a virtually conclusive determinant, and not merely a secondary indicator, of patentability.

Our decision that the statute calls for application as written, comes down in the last analysis to a conviction that while Congress has provided for limited monopoly as a means of enhancement of the industrial arts, it never intended to give such a monopoly to a person whose contribution could fairly be regarded as one that was obvious to a person of "ordinary skill" in the pertinent art. Some skill is inherent in the concept of ordinary skill, and it may be that the reference point moves close to that of the ordinary observer when the standard of skill comes to be applied by an ordinary judge who lacks that skill. But such problems are frequently encountered and the law copes with them as best it can. To move outright to the average observer as the definition of the ultimate standard would, we think, tend to proliferate monopolies beyond the range fairly contemplated by Congress.

Affirmed.

Memorandum of United States District Court

(Filed—March 11, 1971.)

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

CIVIL ACTION No. 2139-68

CONSOLIDATED FOODS CORP.,

Plaintiff,

v.

WILLIAM E. SCHUYLER, JR., Commissioner of Patents,

Defendant.

This is an action brought against the Commissioner of Patents under the provisions of 35 USC 145 seeking a mandatory decree from the Court entitling the plaintiff to receive Design Letters Patent for the ornamental design of a writing implement described and claimed in patent application Serial No. D-1184. The application was filed February 25, 1966 in the Patent Office.

On July 24, 1967 applicant's claim was finally rejected by the Patent Office on the basis of obviousness under 35 USC 103. A design must be more than novel. Title 35 USC 103 denies patentability to a novel design if the differences between the design and the prior art are such that the design would have been obvious to one skilled in the art.

"The test for obviousness, which must be applied as critically to designs as to other inventions, is: 'the scope and content of the prior art are to be determined; difference between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.'" *Blumcraft of Pittsburgh* v. *Citizens & Southern Natl. Bank,* 407 F.2d 557, 559 (4th Cir. 1969), citing *Graham* v. *John Deere Co.,* 338 US 1, 17 (1966).

While it appears that applicant's design is not identical with any single reference, although such differences as there are appear to be relatively minor, the similarity of appearance of the applicant's design to the prior art is more than passing.

Of the references, Platt, D189,735, February 7, 1961 is the principal and compelling one. It shows a writing instrument of similar type to that of applicant's wherein the barrel portion above the annular ring is round in cross section, gradually is flattened on the sides by means of facets and is substantially squared at the top. The squared top portion is similarly provided at the top of the barrel with a push button of similar configuration as the top of the barrel and both the top of the push button and the top of the barrel have been angled downward. (Examiner's Answer to Applicant on appeal to the Board of Appeals, p. 2.)

Design patents consist of combinations and must be weighed by their overall esthetic value. In considering them, the question is not one of mechanical novelty or lack thereof, but one of creative artistry. *Bolte and Weyer Co.* v. *Knight Light Co.,* 180 Fed. 412 (7th Cir. 1910).

In order to warrant patentability the design must produce a new impression upon the eye. Distinctiveness in the overall or general appearance of an article when compared with the prior art rather than isolated and miniscule detail is the test of patentability.[1] Therefore, viewing plaintiff's application in its *entirety* against the background of the prior art, it does not present any new or compelling esthetic appearance which would lead to a thorough conviction that the Patent Office was wrong in its rejection. *Pro-Col Corp.* v. *Comm. of Patents,* Ct. of App. D. C. No. 23,767, Nov. 25, 1970.

During trial, evidence was adduced ostensibly showing commercial success for the purpose of rebutting the possible conclusion of obviousness. Evidence as to such success is certainly admissible. However, as pointed out by the Supreme Court, it is only of a secondary character, and critical only when the question of obviousness is in doubt. *Graham* v. *John Deere Co.,* 338 U.S. 1, 35, 36 (1966); *Higley* v. *Brenner,* 387 F.2d 855 (D.C.Ct. of App. 1967).

Judgment for defendant. Counsel will prepare tentative findings of fact and conclusions of law and order.

MATTHEW F. MCGUIRE,
United States District Judge.

March 11, 1971

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[1] In Re Laverne, 356 F. 2d 1003, 53 CCPA 1158 (1966).

Decision of Board of Appeals
(Mailed—July 1, 1968)

Group 290 Paper No. 13

Appeal No. 824-49

Hearing:

June 10, 1968

IN THE UNITED STATES PATENT OFFICE

BEFORE THE BOARD OF APPEALS

Ex parte Murray Fields

Application for Patent filed February 25, 1966, Serial No. D-1,184. Writing Implement.

Edward Halle for appellant.

Before Kreek, Keely and Strader, Examiners-in-Chief.

Kreek, Examiner-in-Chief.

This is an appeal from the final rejection of the following claim:

> —The ornamental design for a writing implement substantially as shown and described.—

Decision of Board of Appeals
(Mailed—July 1, 1968)

The references relied upon are:

Harper et al.	D. 179,538	Jan. 15, 1957
Bunn et al.	D. 188,267	June 21, 1960
Platt	D. 189,735	Feb. 7, 1961

We have carefully reviewed the record herein and, as a result thereof, we find no reversible error in the Examiner's holding that the subject matter of the claims on appeal is made obvious to one ordinarily skilled in the art by the prior art.

It is true that appellant's design is not identical with that of any single reference. A close inspection will reveal minor differences, however, as in *In re Phillips, Jr.*, 50 CCPA 1223, 315 F. 2d 943, 1963 C.D. 382, 794 O.G. 276, 137 USPQ 369, relied on by the Examiner, there is a striking similarity of appearance of appellant's design to the prior art.

It seems to us that appellant's design is so similar to the prior art, especially the Platt patent, that it would be taken as a mere modification of the prior art, rather than a new design. *In re Johnson*, 36 CCPA 1175, 627 O.G. 911, 175 F. 2d 791, 82 USPQ 199, 1949 C. D. 458.

The decision of the Examiner is affirmed.

AFFIRMED

Edward Halle
600 Old Country Road
Garden City, N. Y. 11532

Final Rejection of United States Patent Office

In Reply Please Refer to the Following and Furnish Your Zip Code:

Group: 292

Applicant: Murray Fields

Ser. No.: D-1184

Filed: Feb. 25, 1966

For: Writing Implement

Mailed: July 24, 1967

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

Responsive to amendment filed June 14, 1967.

The application has been amended and the proposed drawing corrections although approved are being held in abeyance pending allowance or appeal of the claim.

On careful reconsideration as to merits it is still believed that the claimed design does not constitute a patentable advance in the art.

Platt teaches the combination of a pen having faceted upper sides and a squared push button at the top. In view of such teaching, the application of the Bunn type flat facets to the cap portion sides of the Star Pictorial item pen and the squaring of the push button thereof in the manner shown by Harper are deemed to be obvious modifications to a person of ordinary skill working in this field and therefore unpatentable under the provisions of 35 USC 103.

Final Rejection of United States Patent Office

The differences pointed out by applicant are believed to be minor variations that are insufficient to patentably distinguish the design in its entirety. It is fundamental that it is distinctiveness in the overall or general appearance of an article when compared with the prior art rather than minute details that constitutes the test of design patentability. (Ex parte Brubaker, 1925 C.D. 133; 340 O.G. 842, Harris and Schafer, Inc. v. Curtiss Aerocar Co., 1935 C.D. 749, 450 O.G. 269; 20 USPQ 312 and In re Braun, 47 CCPA 817; 1960 C.D. 155; 757 O.G. 778).

Moreover, as was stated by the court in the case of In re Phillips, 50 CCPA 1223; 794 O.G. 276; 137 USPQ 369, the issue is not whether a reference anticipates the disclosure but whether the design would be obvious under 35 USC 103. In view of the teachings of the prior art it is the Examiner's position that applicant has not met the prerequisite for patentability set forth by 35 USC 103.

Accordingly, the rejection is repeated and now made *Final.*

A shortened statutory period for response to this action is set to expire three months from the date of this letter (819 O.G. 895).

EDWIN H. HUNTER
Examiner

LJPerlstein:sfg

Area Code 703
521-5600 Ext. 2265

Judgment of the United States Court of Appeals for the District of Columbia

ON CONSIDERATION THEREOF IT IS ordered and adjudged by this Court that the judgment of the District Court appealed from in this cause is hereby affirmed.

Per Curiam

For the Court:

HUGH E. KLINE
Hugh E. Kline
Clerk

Dated: October 16, 1972.

Opinion by Circuit Judge Leventhal.